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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
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Rydbeck et al.)
)
Serial No. 09/025,395)
)
Filed: February 18, 1998)
)
For: **CELLULAR PHONE WITH EXPANSION MEMORY FOR AUDIO AND VIDEO STORAGE**)
)

Examiner
Banks Harold, M.
Art Unit 2682

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Attorney's Docket No. P-4015-100

Raleigh, North Carolina
January 26, 2001

Box Non-Fee Amendment
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Response to Office Action Rejection

This Response is in reply to the Office Action dated December 17, 2000. If any fees for the Response are required, the Applicants submit that this be considered a Petition therefore, and the Commissioner is hereby authorized to charge Deposit Account 18-1167.

Claims 11-23 were pending in the application with the Examiner indicating that newly submitted claims 20-23 were being withdrawn from consideration as being directed to a non-elected invention. Claims 11-19 were rejected.

The present invention is directed to a cellular telephone comprising a transceiver unit for transmitting and receiving audio and data signals, and a

microprocessor for controlling the operation of the transceiver. A signal processing circuit operatively connects the transceiver and microprocessor for processing signals transmitted and received by the transceiver. An entertainment module having a computer memory connected to the microprocessor and signal processing circuits stores the audio and video for subsequent playback under the control of the microprocessor. For purposes of this application, memory means all forms of computer memory but dies not include disk storage, tape storage or other memory requiring electromechanical read systems. The memory may be in the form of a removable ROM cartridge and/or an expansion RAM. In those embodiments having an expansion RAM, an input port is provided for loading music or other audio signals into the expansion RAM from a CD player, computer, or other source of digitized audio (specification page 3, lines 1-6).

Claim 11 has been rejected under 35 U.S.C. 102(e) as being anticipated by U.K. patent application GB2308775A (hereinafter Futami). Futami discloses a portable telephone set and entertainment unit having a wireless headset. As illustrated schematically in Figure 2, the main body unit includes an electromechanical audio reproduction unit which may take the form of a portable cassette tape (page 5, line 4) a compact disc, a mini disc, similar disc type device, or a radio receiver such as a radio set (page 14, lines 8-11).

Claim 11 includes the term "memory" which should be interpreted as described in the specification. Using this interpretation, claim 11 is clearly not anticipated by this reference. The Examiner gives the term "computer memory"

the broadest interpretation stating that a term in a claim may not be given a meaning repugnant to the usual meaning of the term (Office Action Summary of 12/18/00, page 3).

While a patentee may not use a term repugnant to the usual meaning, he may be his own lexicographer and use terms contrary to or inconsistent with one or more of their ordinary meanings. Manual of Patent Examining Procedure, §2173.05(a), citing *Hormone Research Foundation Inc. v. Genetech Inc.,* 15 U.S.P.Q.2d 1039 (Fed. Cir. 1990). When there is more than one accepted meaning to a term, the applicant must make clear which definition is being relied upon to claim the invention. Id.

A term having a broad, general meaning may be given a more restrictive definition by an Applicant without being considered repugnant. *In re Paulsen,* 31 U.S.P.Q.2d 1671, 1674 (Fed. Cir. 1994). In *Paulsen*, the Court was attempting to determine the Applicant's meaning of the claim term "computer". The Court states:

> [t]he term 'computer' is not associated with any one fixed or rigid meaning, as confirmed by the fact that it is subject to numerous definitions and is used to describe a variety of devices with varying degrees of sophistication and complexity.

Id.

Although the Court searched for an indication of a more specialized definition, the broad meaning of the term was applied because the Applicant did not clearly define the desired meaning. However the Applicant would have been given a more restrictive meaning for the claim language if the Applicant's intention to do

so was indicated with precision, clarity, and deliberateness. Id. citing *Intellicall, Inc. v. Phonometrics, Inc.*, 21 U.S.P.Q.2d 1383, 1386 (Fed. Cir. 1992).

In the present case, the Examiner incorrectly expands the intended meaning of the term "memory" such that the claim may be anticipated by Futami. The Applicant's have clearly defined the term "memory" to be used in a more restrictive manner than the broad, general definition normally associated with the term. The Applicants use of the term "memory" is not used in a repugnant manner within the claim, but rather in a manner consistent with an acceptable meaning of the term. That is, the Applicant has simply opted to use a narrow rather than a broad definition of computer memory.

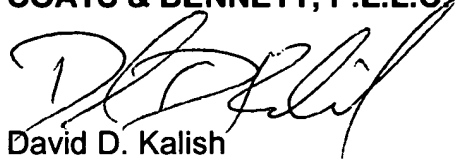
When claim 11 is interpreted correctly, it excludes electromechanical devices. Claims 11-19 are not anticipated or obvious because the so-called memory in Futami is in fact a machine-readable medium such as a cassette tape or compact disk, which requires an electromechanical drive.

The previous amendment to claim 11 adding the term "computer" before "memory" was done to further demonstrate to the Examiner that the invention of claim 11-19 is directed to a device with memory as defined within the specification. When the claim is properly construed, the term "computer" does not change the scope of the claim and was not added in view of prior art.

In light of the above amendments and remarks, claims 11-19 are in condition for allowance and such action is respectfully requested. If any issues remain unresolved, the applicant's attorney requests a telephone interview to expedite allowance and issuance.

Respectfully submitted,

COATS & BENNETT, P.L.L.C.

By: 

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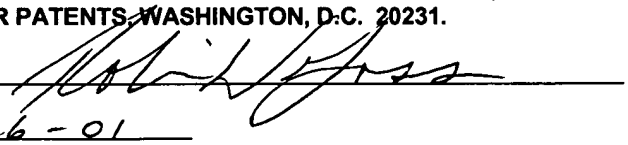
SIGNATURE: 

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